

## **REMARKS**

Claims 1-69 are pending in the above application and have been rejected in the most recent Office Action. Claim 1 has been amended to incorporate the subject matter of Claims 7, 10, 11 and 14; Claim 26 has been amended to incorporate the subject matter of Claims 29-31, and 35; Claim 37 has been amended to incorporate the subject matter of Claims 40 and 41; Claim 46 has been amended to incorporate the subject matter of Claims 50 and 55-57; Claims 7, 10, 11, 14, 29-31, 35, 40, 41, 50, 55-57, 62-64 and 66 have been cancelled hereinabove. Applicants respectfully traverse each ground of rejection and request reconsideration and further examination of the application. Applicants respond to each ground of rejection and objection as follows:

**A. Claims 26, 27 and 37 have been provisionally rejected under the judicially created doctrine of double patenting over Claims 1, 21, 30, 33 and 43 of copending Application No. 09/705,252.**

A terminal disclaimer referencing U.S. Patent Application Serial No. 09/705,252 is included herewith. Thus, the rejection of Claims 26, 27 and 36 over the '252 patent application is obviated. Applicant respectfully submits that Claims are no longer objectionable and reconsideration is respectfully requested.

**B. Claims 26, 32 and 33 were rejected under 35 USC § 102(e) as being anticipated by LeRoy (USPN 5,970,474).**

LeRoy discloses a system that allows users to use a product selection device to choose items in a retail store. The items are then communicated to a registry database on a host computer via a local area network (LAN). The registry database includes items that a user has selected using the product selection device. LeRoy also discloses a point of sale input device

that identifies purchased items and updates the registry database to indicate which items have been purchased. LeRoy further discloses a system whereby registry databases at individual retail stores can be synchronized with a master registry database across a wide area network (WAN), such as the Internet.

Claim 26 has been amended hereinabove to require “using SKU data to identify the physical retailer where an item was scanned; determining the identity of the physical retailer by using the SKU data and data identifying a particular mall; providing the user's personal preferences to one or more buyers via the Web site; associating scanned items with a member identification number; associating a plurality of member identification numbers with one registered user; and requiring a buyer to enter a password to access a Private wish list; wherein the SKU data includes data identifying the physical retailer”. Neither LeRoy nor any of the other prior art references of record disclose, teach or suggest a system wherein the registrant/user may optionally designate whether a list be publicly viewable or private and viewable only after a password is given. It is therefore respectfully submitted that Claim 26, as amended, is now allowable over the prior art of record.

Claims 32 and 33 depend from independent Claim 26 and therefore include all of the limitations of Claim 26, as amended. It is, therefore, respectfully submitted that Claims 32 and 33 are each allowable over the references of record for at least the same reasons as set forth above regarding Claim 26.

**C. 1-6, 8-10, 12, 13, 15, 19-21, 24, 25, 58-61, 63-65 and 67-69 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy, in view of Robertson (USPN 6,609,106), and further in view of Official Notice (regarding well within the skill hereinafter referred to as “ON1”).**

Claims 10, 63 and 64 have been cancelled hereinabove. Therefore, the rejection of Claims 10, 63 and 64 is moot.

LeRoy discloses a system that allows users to use a product selection device to choose items in a retail store. The items are then communicated to a registry database on a host computer via a local area network (LAN). The registry database includes items that a user has selected using the product selection device. LeRoy also discloses a point of sale input device that identifies purchased items and updates the registry database to indicate which items have been purchased. LeRoy further discloses a system whereby registry databases at individual retail stores can be synchronized with a master registry database across a wide area network (WAN), such as the Internet.

Robertson discloses a system and method that allows users to create a gift registry including products from multiple on-line merchants. The selected items are then stored centrally in a database as elements of a wish list by sending information over the Internet to a centralized gift registry site. Robertson also discloses a system whereby individual gift purchasers can make purchases for a registrant using the wish list. The wish list items can be searched and organized by price or category. Robertson also discloses that the purchase of all items in the wish list can be delayed to a certain specified date corresponding to a future time or event. Additionally, registrants of the system can receive an automatic notification upon the arrival of the specified time or event.

ON1 asserts that “it is well within the skill to ascertain that accepted business retail practices allow potential gift registry registrants to physically collect item information in a store

prior to registering, in order to allow a potential registrant an opportunity to determine whether the retailers goods are suitable to the potential registrant's wish list." Applicants respectfully traverse ON1 since the Claim element ON1 is directed toward is that of ordering the registration step after the 'scanning items' step. The Claim element does not contemplate the physical collection of information from a store; in fact, the Claim element does not contemplate the collection of information at al, but merely establishes the order of registration as after scanning items.

Claim 1 has been amended to include "wherein the user can designate the personal preferences Public; wherein the user can designate the personal preferences Private such that a password is required for buyers to access the personal preferences; and wherein the processor is further programmed to require a buyer to enter a password to access a Private wish list". None of the prior art references of record disclose, teach or suggest a system wherein the registrant/user may optionally designate whether a list be publicly viewable or private and viewable only after a password is given. Robertson only mentions the use of a password in connection with the registrant/user's access to the system, and LeRoy likewise only discusses the use of password protection in the context of the user's and the service provider's access to the system. In other words, both LeRoy and Robertson only discuss the use of a password to restrict access to a list to add, change and/or remove items from the list. None of the references of record disclose, teach or suggest restricting 'wish list' or 'buy list' access via password protection.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must

teach or suggest all of the Claim limitations. MPEP § 706.02(j). Specifically, the combination cited in the most recent Office Action does not teach a concierge service making a physical purchase on behalf of a buyer or listed user. LeRoy and Robertson disclose systems in which wish lists are created and made readily available to third party buyers for online shopping, but do not disclose any method or system wherein the viewing of such wish lists may be made selectively restricted or password protected. Therefore, a prima facie case of obviousness has not been made. The cited references do not, alone or in combination, teach or suggest the combination of elements of Applicants' Claim 1. It is therefore respectfully submitted that Applicant's Claim 1 is allowable over the above-cited art. It is respectfully requested that the above rejection be withdrawn.

Claims 2-6, 8, 9, 12, 13 and 15-25 depend from Claim 1 and therefore include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-6, 8, 9, 12, 13 and 15-25 are allowable over the references of record for at least the same reasons as set forth above regarding Claim 1.

Likewise, Claim 58, as amended, now requires "requiring a buyer to enter a password to access a Private wish list". As discussed above, LeRoy and Robertson disclose systems in which wish lists are created and made readily available to third party buyers for online shopping, but do not disclose any method or system wherein a buyer is required to enter a password to access a wish list. Therefore, a prima facie case of obviousness has not been made. The cited references do not, alone or in combination, teach or suggest the combination of elements of Applicants' amended Claim 58. It is therefore respectfully submitted that Applicant's Claim 58 is allowable over the above-cited art. It is respectfully requested that the above rejection be withdrawn.

Claims 59-61, 63-65 and 67-69 depend from Claim 58 and therefore include all of the limitations of Claim 58. It is therefore respectfully submitted that Claims 59-61, 63-65 and 67-

69 are allowable over the references of record for at least the same reasons as set forth above regarding Claim 58.

- D. Claims 7 and 62 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy and Robertson and ON1, as applied to Claims 1 and 58, further in view of Official Notice (regarding well within the skill hereinafter referred to as ON2).**

Claims 7 and 62 have been cancelled hereinabove. Therefore, the rejection of Claims 7 and 62 is moot.

- E. Claims 11, 14 and 66 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy and Robertson and ON1, as applied to Claims 1, 8 and 58, further in view of Official Notice (regarding well within the skill hereinafter referred to as ON3).**

Claims 11, 14 and 66 have been cancelled hereinabove. Therefore, the rejection of Claims 11, 14 and 66 is moot.

- F. Claims 16-18 and 22-23 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy and Robertson and ON1, further in view of various combinations of Schwartz et al. (USPN 5,913,032), Official Notices (regarding well within the skill hereinafter referred to as ON4 and ON5) and Wireless Data News (PTO-892, Item U, hereinafter referred to as WDA).**

Claims 16-18 and 22-23 depend from amended Claim 1, which has been amended to include “wherein the user can designate the personal preferences Public; wherein the user can designate the personal preferences Private such that a password is required for buyers to access the personal preferences; and wherein the processor is further programmed to require a buyer to enter a password to access a Private wish list”. None of the prior art references of record disclose, teach or suggest a system wherein the registrant/user may optionally designate whether

a list be publically viewable or private and viewable only after a password is given. As noted above, Robertson only mentions the use of a password in connection with the registrant/user's access to the system, and LeRoy likewise only discusses the use of password protection in the context of the user's and the service provider's access to the system. Thus, none of the references of record disclose, teach or suggest restricting 'wish list' or 'buy list' access via password protection.

Claims 16-18 and 22-23 depend from Claim 1 and therefore include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 16-18 and 22-23 are allowable over the references of record for at least the same reasons as set forth above regarding Claim 1.

**G. Claims 27 and 34 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy and Robertson; Claim 36 was rejected under 35 USC § 103(a) as being unpatentable over LeRoy, Robertson and ON3 as applied to claim 26, further in view of ON4; and Claim 28 was rejected under 35 USC § 103(a) as being unpatentable over LeRoy and in view of ON1.**

Claim 26 has been amended to include "providing the user's personal preferences to one or more buyers via the Web site; associating scanned items with a member identification number; associating a plurality of member identification numbers with one registered user; and requiring a buyer to enter a password to access a Private wish list; wherein the SKU data includes data identifying the physical retailer", which are not disclosed, taught or suggested by LeRoy or Robertson. As discussed above, none of the prior art references of record disclose, teach or suggest a system wherein the registrant/user may optionally designate whether a list be publicly viewable or private and viewable only after a password is given. Further, none of the references of record disclose, teach or suggest restricting 'wish list' or 'buy list' access via password protection.

Robertson only mentions the use of a password in connection with the registrant/user's access to the system, and LeRoy likewise only discusses the use of password protection in the context of the user's and the service provider's access to the system; LeRoy and Robertson disclose systems in which wish lists are created and made readily available to third party buyers for online shopping, but do not disclose any method or system wherein the viewing of such wish lists may be made selectively restricted or password protected. Therefore, a prima facie case of obviousness has not been made. The cited references do not, alone or in combination, teach or suggest the combination of elements of Applicants' Claim 26. As Claims 27, 28, 34 and 36 depend from Claim 26 and therefore include all of the limitations of Claim 26, it is therefore respectfully submitted that Claims 27, 28, 34 and 36 are allowable over the references of record for at least the same reasons as set forth above regarding Claim 26.

**H. Claims 29-31 and 35 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy and in view of various combinations of Robertson with ON1 and ON3.**

Claims 29-31 and 35 have been cancelled hereinabove. Therefore, the rejection of Claims 29-31 and 35 is moot.

**I. Claims 37, 38, 41-43, 46-48, 51-53, 55 and 56 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy in view of Robertson; Claims 39, 40, 44, 45, 49, 50, 54 and 57 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy in view of Robertson and further in view of ON1, ON2, ON3 and/or ON4.**

Claims 41, 55 and 56 have been cancelled hereinabove. Thus, the rejection of Claims 41, 55 and 56 is moot.



Claim 37 as amended includes “using SKU data to identify the physical retailer where an item was scanned; and providing the user's personal preferences to one or more buyers via the Web site”. Neither LeRoy nor Robertson disclose using SKU data to identify the physical retailer where an item was scanned. Applicants respectfully traverse ON2, which recites that it is considered well within the skill to ascertain that buyers desiring to purchase an item from the wish list need to know where the item can be found. This is simply not the case. A primary feature of the present invention is providing the ease of online shopping, or, alternately, concierge shopping, to the buyer. In both online and concierge shopping, the buyer does not need to know from where the gift comes. In contrast, it is sometimes of interest to the mall property owner to know which stores are getting the most pedestrian traffic and which are receiving substantial online shopping business. Such concerns are not disclosed in the prior art of record, nor are they addressed by the Official Notices. Therefore, a prima facie case of obviousness has not been made. The cited references do not, alone or in combination, teach or suggest the combination of elements of Applicants' Claim 37. It is therefore respectfully submitted that Applicant's Claim 37 is allowable over the above-cited art. It is respectfully requested that the above rejection be withdrawn.

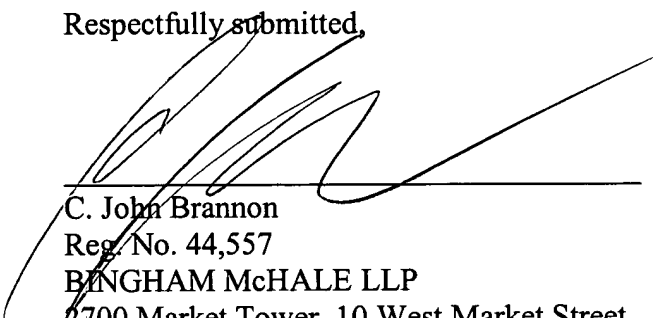
Claims 38, 42, 43, 46-48, and 51-53 depend from Claim 37 and therefore include all of the limitations of Claim 26, it is therefore respectfully submitted that Claims 38, 42, 43, 46-48, and 51-53 are allowable over the references of record for at least the same reasons as set forth above regarding Claim 37.

In the event Applicants have overlooked the need for an extension of time or payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 50-0410, BINGHAM McHALE LLP.

### CONCLUSION

Reconsideration of the present application in view of the foregoing arguments is respectfully requested. Applicants respectfully submit that the above represents a complete response to the Office Action of January 11, 2005, and that the application is in condition for allowance. Such action is respectfully requested.

Respectfully submitted,



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